

REMARKS

This Response is submitted in response to the Office Action dated July 30, 2003, and in accordance with the personal interview courteously granted to Applicants' representatives on November 5, 2003.

Claims 1 to 5, 23, 24 to 28, 29 and 30 are amended herein. No new matter is added by these amendments.

Claims 6 to 8 which depend from amended Claim 1 remain withdrawn. However, it is respectfully submitted that since Claim 1 is now in condition for allowance for the reasons discussed below, Claims 6 to 8 should be considered.

Claims 9 to 22 remain withdrawn. Applicant will cancel such claims when the Examiner indicates the remaining claims are allowable.

Claims 25 to 28 which the Examiner indicated were withdrawn have been amended in accordance with Claim 23 and it is respectfully submitted that such claims should be examined

A Supplemental Information Disclosure Statement is submitted herewith. A Petition for a Two Month Extension of Time to respond to the Office Action is submitted herewith. Checks in the amount of \$420.00 and \$180.00 are submitted herewith to cover the cost of the Supplemental Information Disclosure Statement and the two month extension. Please charge Deposit Account No. 02-1818 for any fees that are deemed necessary.

A. The Rejection

The Office Action rejected Claims 1 to 5, 23, 24, and 29 to 31 under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being obvious in view of U.S. Patent No. 6,589,114 to Rose ("Rose"). Applicants respectfully disagree and traverse these rejections for the reasons discussed below. Additionally, Applicants have amended the claims to focus the claims on one embodiment of the present invention (which has been previously elected in response to the restriction

requirement). Applicants reserves the right to file one or more continuation or divisional applications to seek protection on the other embodiments.

B. Rose is not prior art to the presently claimed invention.

Rose is not prior art to the presently claimed invention. The presently claimed invention was conceived prior to the filing date of July 25, 2001 of Rose as demonstrated by the previously submitted Affidavit of Darren Maya. The Affidavit demonstrates that art work was being prepared for a commercial embodiment of the present invention at least as early as May 8, 2001. The conception date of the present invention is thus sometime prior to May 8, 2001.

The Office Action indicated that this Affidavit was not appropriate because the Rose patent claims the present invention. Certain of the claims have been amended such that the presently claimed invention is clearly directed to a different invention than the invention disclosed or claimed in Rose. Therefore, no interference can be declared between Rose and the present application. Rose claims

The Rose independent Claims are as follows:

1. A method of conducting a game of chance on a gaming machine controlled by a processor, comprising:
receiving a wager from a player;
displaying a sequence of value-based symbols in a symbol array having multiple rows and columns, the sequence defining a first award;
re-ordering the sequence of value-based symbols in view of the symbol array such that the re-ordered sequence defines a second award; and
awarding the second award to the player.

7. A method of conducting a game of chance on a gaming machine controlled by a processor, comprising:
receiving a wager from a player;

randomly selecting symbols for placement in a displayed symbol array including multiple rows and columns;
triggering a shuffle feature in response to the displayed symbols including a sequence of value-based symbols, the sequence defining a first award;
re-ordering the sequence of value-based symbols in view of the symbol array such that the re-ordered sequence defines a second award; and
awarding the second award to the player.

12. A game of chance for a video gaming machine controlled by a processor in response to a wager, comprising:
means for displaying a sequence of value-based symbols in a symbol array having multiple rows and columns, the sequence defining a first award;
means for re-ordering the sequence of value-based symbols in view of the symbol array such that the re-ordered sequence defines a second award; and
means for awarding the second award to the player.

13. A game of chance for a video gaming machine controlled by a processor in response to a wager, comprising:
means for randomly selecting symbols for placement in a displayed symbol array having multiple rows and columns;
means for triggering a shuffle feature in response to the displayed symbols including a sequence of value-based symbols, the sequence defining a first award;
means for re-ordering the sequence of value-based symbols in view of the symbol array such that the re-ordered sequence defines a second award; and
means for awarding the second award to the player.

These are clearly directed to different inventions than the claims in the present application.

More specifically, amended Claim 1 is directed to a gaming device including a display device, a processor, a gaming event and a plurality of different award modification methods wherein one of the award modification methods individually adds a digit to the digits of the original award. The display device displays an original award having a plurality of digits. The original award results from the gaming event played by a player. The digits indicate an amount of the claim or original award. The processor determines whether to modify said original award and if the determination is made to modify the original award (a) selects one of the plurality of different award modifications methods, (b) causes the selected award modification method to modify the digits of the original award, (c) causes the display device to display said modified digits and (d) provides a modified award to a player wherein the modified digits indicate the amount of the modified award. Rose does not claim or disclose the combination of (1) a plurality of different award modifications methods wherein one of the award modification methods individually adds a digit to the digits of the original award, (2) the processor determining whether to modify the original award, (3) the selection of one of the different award modification methods if the determination is made to modify the award, and (4) the modification of the award using such method. Therefore, the Rose invention and the presently claimed invention are substantially different, an interference between such claims is not proper, and Rose is not prior art in view of the previously submitted Affidavit.

Claim 23 is directed to a gaming device including a display device, a processor that communicates with the display device, a gaming event, a plurality of different award modification methods wherein one of the award modification methods individually adds a digit to the digits of the original award, and a player selectable modify input which communicates with the processor. The display device displays an original award including a plurality of digits. The original award results from the gaming event played by a player. The digits indicate an amount of the original award. An activation of the

player selectable modify input initiates one of the award modification methods selected from the plurality of award modification methods which are adapted to modify at least one of the digits of the original award. Rose does not claim or disclose this invention. Therefore, an interference would be improper, and Rose is not prior art in view of the previously submitted Affidavit.

Claim 29 is directed to a gaming device including a display device, a processor that communicates with the display device, a gaming event and a plurality of different award modification methods wherein one of the award modification methods individually adds a digit to the digits of the original award. The display device display an original award including a plurality of digits. The original award results from the gaming event played by a player. The digits indicate an amount of the original award. The processor randomly initiates one of the modification methods selected from the plurality of modification methods which are adapted to modify at least one of the digits of the original award. Rose does not claim or disclose this invention. Therefore an interference would be improper, and Rose is not prior art in view of the previously submitted Affidavit.

Amended Claim 30 is directed to a gaming device operated under the control of a controller. The gaming device includes a display device, a gaming event, an original award represented by a plurality of individual digits displayed by the display device, said original award resulting from a gaming event played by a player and wherein the digits indicate an amount of the original award, a final award, and a plurality of different award modification methods stored by the controller and including a rearrangement of at least two of the digits of the original award, an addition of a digit to the digits of the original award, a removal of one of the digits of the original award, and a modification of at least one of the digits of the original award. The final award includes a modification of the digits of the original award. The modified digits of the original award indicate an amount of the final award. The modification method for modification of the original award is selected from the plurality of different award modification methods stored by the controller. Rose does not claim or disclose this invention. Therefore an interference

would be improper, and Rose is not prior art in view of the previously submitted Affidavit.

Since Rose is not prior art to the presently pending claims, the rejection should be withdrawn.

C. The rejection based on Rose uses improper hindsight.

The Office Action states that "Rose does not explicitly teach the limitations of [a] gaming device comprising a plurality of different award modification methods; a player selectable award modify input which communicates with the processor; and an activation which initiates one of the selected award modification methods . . ." The Office Action further states that this is "inherently known from the gaming industry, i.e., new features and themes for bonus games." The Office Action concludes that "it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to modify Rose's award modification system and method by adding more award modification features and themes to video gaming to provide more attractive gaming and excitement to game players." Applicants respectfully disagree and traverse this reasoning and rejection.

Rose does not disclose, teach or suggest these elements. This reasoning is based on improper hindsight. Obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the claimed invention. *ATD Corp v. Lydall, Inc.*, 48 U.S.P.Q. 2d 1321, 1329 (Fed. Cir. 1998). The Federal Circuit stated that:

[v]irtually all inventions are necessarily combinations of old elements. The notation, therefore, that combination claims can be declared invalid merely upon finding similar elements in separate Prior patents would necessarily destroy virtually all patents and cannot be the law under the statute, § 103.

Panduit Corporation v. Dennison Manufacturing Co., 810 F.2d 1561, 1575 (Fed. Cir. 1987). The Federal Circuit specifically cautioned that:

[a]s this court has stated, "virtually all [inventions] are combinations of old elements." Therefore, an examiner [or accused infringer] may often find

every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner [or accused infringer] to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention.

....

... To counter this potential weakness in the obviousness construct, the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.

Yamanouchi Pharmaceutical Co., Ltd., et al v. Danbury Pharmacal, Inc., et al., 231 F.3d 1339, 1343 (Fed. Cir. 2000) (Rehearing and Rehearing En Banc Denied, December 14, 2000).

When the Patent Office fails to explain how the skilled artisan would have been specifically motivated by the prior art to make the claimed combination, the court infers that the obviousness determination has been impermissibly made in hindsight. *In re Rouffet*, supra, (citing *In re Gorman*, 18 U.S.P.Q. 2d 1885, 1888 (Fed. Cir. 1991)). The M.P.E.P. mandates that impermissible hindsight must be avoided and the legal conclusion of obviousness must be reached on the basis of the facts gleaned from the prior art (See M.P.E.P. §2141.03). Although, as stated in case law often relied on by the U.S. Patent Office (See e.g., paragraph A of subsection X of § 2145 of the M.P.E.P.), that “[a]ny judgment of obviousness is in a sense necessarily a reconstruction based on hindsight reasoning” *In re MacLaughlin* 443 F.2d 1392, 1395, 170 U.S.P.Q. 209, 212 (CCPA 1971), this nonetheless does not relieve the Patent Office of ensuring that the obviousness determination takes into account only knowledge which was with the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned from the applicant’s disclosure.

In this case, the Office Action’s statements that this in “inherently know from the gaming industry, i.e., new features and themes for bonus games” and that “adding more award modification features and themes to video gaming to provide more attractive gaming and excitement to game players” are general reasons for any changes to Rose

rather than specific reasons for the changes to Rose as required by the Federal Circuit to support the conclusion of obviousness. If such reasoning were an appropriate basis for finding inventions obvious, it would be virtually impossible to patent any invention in the gaming field.

Rose does not disclose, teach or suggest the invention of amended Claim 1. Rose does not disclose, teach or suggest the combination of: (a) a plurality of different award modification methods wherein one of the award modification methods individually adds a digit to the digits of the original award, (b) the processor determining whether to modify said original award, (c) if the determination is made to modify the original award, selecting one of the plurality of different award modifications methods, or (d) causing the selected award modification method to modify the digits of the original award.

Rose does not disclose, teach or suggest the invention of Claim 23. Rose does not disclose, teach or suggest the combination of: (a) a plurality of different award modification methods which are adapted to modify at least one of the digits of the original award wherein one of the award modification methods individually adds a digit to the digits of the original award, (b) a player selectable modify input, and (c) an activation of the player selectable modify input initiating one of the award modification methods selected from the plurality of award modification methods.

Rose does not disclose, teach or suggest the invention of Claim 29. Rose does not disclose, teach or suggest the combination of: (a) a plurality of different award modification methods wherein one of the award modification methods individually adds a digit to the digits of the original award, and (b) the processor randomly initiating one of the modification methods selected from the plurality of modification methods which are adapted to modify at least one of the digits of the original award.

Rose does not disclose, teach or suggest the invention of amended Claim 30. Rose does not disclose, teach or suggest the combination of: (a) a plurality of different award modification methods stored by a controller and including a rearrangement of at least two of the digits of the original award, an addition of a digit to the digits of the original award, a removal of one of the digits of the original award, and a modification of at least one of the digits of the original award; (b) the modification method for



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modification of the original award being selected from the plurality of different award modification methods stored by the controller.

Accordingly, it is respectfully submitted that, assuming arguendo, Rose is prior art, the pending claims are patentably distinguished over Rose and in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicants respectfully request that the Examiner contact the undersigned.

Respectfully submitted,

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